



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
[www.uspto.gov](http://www.uspto.gov)

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/715,766	11/18/2003	Iwan Wolf	DT-6666	5255
30377	7590	06/14/2004		EXAMINER
DAVID TOREN, ESQ. SIDLEY, AUSTIN, BROWN & WOOD, LLP 787 SEVENTH AVENUE NEW YORK, NY 10019-6018			LOPEZ, MICHELLE	
			ART UNIT	PAPER NUMBER
			3721	

DATE MAILED: 06/14/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/715,766	WOLF ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Michelle Lopez	3721	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 18 November 2003.  
 2a) This action is **FINAL**.                    2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-8 is/are pending in the application.  
 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_\_ is/are allowed.  
 6) Claim(s) 1-8 is/are rejected.  
 7) Claim(s) \_\_\_\_\_ is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on 18 November 2003 is/are: a) accepted or b) objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
|  | 6) <input type="checkbox"/> Other: _____                                    |

**DETAILED ACTION**

***Priority***

1. Acknowledgment is made of applicant's claim for foreign priority under 35 U.S.C. 119(a)-(d). The certified copy has been received.

***Drawings***

2. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the limitation of "several retaining elements with a separate magnetic conducting element being associated with each retaining element", disclosed in claim 2, must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted

by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

- A person shall be entitled to a patent unless –
- (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.
3. Claims 1-3 and 6 are rejected under 35 U.S.C. 102(b) as being anticipated by Bolte (US 3,584,776). Bolte'776 discloses a setting tool with one combustion chamber "18", a piston guide "4", a drive piston "5", a magnetic piston-retaining means as a permanent magnet "16" for temporarily retaining the drive piston "5", and a magnetic flux-conducting element "13" for transmitting a magnetic holding force from the magnetic piston-retaining means "16" to the drive piston "5".

So far claim 2, it is deemed that the magnetic piston-retaining mean "16" comprises several retaining elements with a separate magnetic conducting element being associated with each retaining element (see col. 1, lines 63-68).

Regarding claim 6, Bolte'776 discloses that the magnetic flux-conducting element "13" is formed of a magnetic flux-conducting iron alloy, i.e. steel, as it is well known in the art that steel is a ferromagnetic material malleable alloy of iron (see col. 2, lines 20-23).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 4-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bolte'776 in view of Averbukh (US 5,497,555). Bolte'776 discloses the invention substantially as claimed. Bolte'776 does not disclose that the magnetic piston-retaining means "16" comprises one electromagnet. However, Averbukh'555 teaches a magnetic piston-retaining means "132", i.e. an electromagnet, for the purpose of controlling the amount of current transmitted via the piston-retaining means "132" to the conducting element "130", thereby adapting the retaining force of the magnetic piston-retaining means "132" to the required operational conditions. In view of Averbukh'555, it would have been obvious to one having ordinary skills in the art to have provided Bolte's invention with a magnetic piston-retaining means, i.e. an electromagnet, in order to control the amount of current transmitted via the piston-retaining means to the conducting element, thereby adapting the retaining force of the magnetic piston-retaining means to the required operational conditions.

Regarding claim 5, Bolte'776 does not disclose that the magnetic flux-conducting element is formed as a pole piece. However, Averbukh'555 teaches a magnetic flux-conducting element "130" formed as a pole piece (see Fig. 3) for the purpose of controlling the magnetic force applied via the electromagnet "132" to the pole piece "130". In view of Averbukh'555, it would have been obvious to one having ordinary skills in the art to have provided Bolte's

invention with a magnetic flux-conducting element formed as a pole piece in order to control the magnetic force applied via the electromagnet to the pole piece.

5. Claims 7-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bolte'776 in view of Bade (US 3,320,860). Bolte'776 discloses the invention substantially as claimed. Bolte'776 does not disclose a spacer formed as a shock-absorbing provided between the magnetic piston-retaining means and the drive piston. However, Bade'860 teaches a spacer "22a" formed as a shock-absorbing element provided between the magnetic piston-retaining means "14" and the drive piston "32" (see Fig. 2) for the purpose of providing a cushioning member that reduces the impacting damage of the drive piston "32" over the magnetic piston-retaining means "14". In view of Bade'860, it would have been obvious to one having ordinary skills in the art to have provided Bolte's invention with a spacer formed as a shock-absorbing provided between the magnetic piston-retaining means and the drive piston in order to cushioning the impact imparted by the drive piston over the magnetic piston-retaining means, thereby preventing wear and/or damage of the magnetic piston-retaining means.

### *Conclusion*

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Juilfs'922, Volkmann'632, Lange'195, Schut'313, Sherman'987, Ward'426, Gschwend'247, Geiger'269, and Bahnen'614 are cited to show related inventions.

Art Unit: 3721

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michelle Lopez whose telephone number is 703-305-8205. The examiner can normally be reached on Monday - Thursday: 8:00 am - 6:00 pm.

8. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rinaldi Rada can be reached on 703-308-2187. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

9. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

ML



SCOTT A. SMITH  
PRIMARY EXAMINER